

**REMARKS**

Applicant has carefully studied the Office Action of June 28, 2004 and offers the following remarks in response thereto.

Initially, Applicant amends claim 16, changing the term "portable memory device" to "portable device" to make the term consistent throughout the claims. No new matter is added.

Applicant provides a brief summary of the present invention so that the remarks are considered in the proper context. The present invention is designed to allow a user with a smart card-like device to operate a host computing device in a secure manner. The programs that the host computing device launches are initiated by the portable device and the software on the portable device causes the host computing device to delete the records relating to the computing session when the computing session is done. It is particularly relevant to note that the software on the portable device is the software that causes these deletions. This is done so that an administrator or other user does not have to perform the deletions manually or configure each of the caches on the various potential host computing devices.

Claims 1, 2, 4-8, 10-12, 14-17, 19-23, 35, 27-29, 31, 32, and 35 were rejected under 35 U.S.C. § 103 as being unpatentable over Paul in view of Boyles et al. (hereinafter "Boyles"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness analysis, the Patent Office must do two things. First, the Patent Office must articulate a motivation to combine the references. Second, the Patent Office must support the articulated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Once the references are properly combined, to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located. MPEP § 2143.03. If the Patent Office cannot show each and every element, then Applicant is entitled to a patent. The Patent Office can modify a combination to show a missing element. However, to make such a modification, the Patent Office is obligated to provide a motivation to modify the combination and then must support this second motivation with additional evidence. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000).

Applicant initially traverses the rejection because the Patent Office has not supported the motivation to combine the references with the evidence that the Federal Circuit has mandated be provided. Specifically, with respect to claim 1, the Patent Office opines that it would have been

obvious to combine the references “to prevent other users from having access to information processed during the computing session of the user via the host computing device once the session is complete.” This assertion is unsupported. Since the motivation is not properly supported, the combination is improper and the references must be considered individually. The Patent Office admits that individually the references do not show each and every claim element and therefore, the Patent Office has not established obviousness. Since the Patent Office has not established obviousness for claim 1, claim 1 and its dependent claims 2-8 and 10-15 are patentable.

Applicant further traverses the rejection because the Patent Office admits that the combination does not show all the claim elements. Specifically, on page 3 of the Office Action, the Patent Office admits that the combination does not teach deletion of the cookies. The Patent Office opines that it would be obvious to include cookie deletion “since cookies are in integral part of user-specific information with regard to a computing session involving the use of the internet.” However, there is no evidence to support this assertion. Since the motivation to modify the combination is not supported with the requisite evidence, the modification to the combination is improper. Since the combination admittedly does not show all the elements without the modification, the Patent Office has not established obviousness for claim 1. Since the Patent Office has not established obviousness for claim 1, claim 1 and its dependent claims 2-8 and 10-15 are patentable.

Even if the combination and the modification are proper, points which Applicant does not concede, the modified combination does not show a claim element. Claim 1 recites that the memory of the portable device contains software. Further, that software is “adapted to delete records of user interaction from the host computing device at the end of a computing session . . . .” The Patent Office opines that this element is taught by Boyles, col. 11, lines 36-45. Applicant traverses this assertion. While Boyles, col. 11, lines 36-45 does discuss that the internet browser shuts down and re-opens to keep onlookers from viewing the last displayed site, this is not software on the portable device’s memory that is performing this function as recited in the claim. Rather, the software on the host computing device performs that function. Likewise, the passage states that the history of the user’s session is erased from the browser, but again, this activity is not done by the software on the portable device. Rather, Boyles explicitly states that this deletion is done by the system administrator turning off the cache on the internet browsers. The

claim recites that the software on the portable device performs the deletion, not the system administrator or the software of the host computing device. The Patent Office's modified combination does not teach or suggest the claim element and thus does not establish obviousness for the claimed invention. Since the Patent Office has not established obviousness for claim 1, claim 1 and its dependent claims 2-8 and 10-15 are patentable.

Claim 16 recites elements substantially similar to those recited in claim 1. The Patent Office relies on the same motivations and the same passage in Boyles to reject the claim. The arguments presented above with respect to these positions apply equally here. Since the Patent Office has not established obviousness for claim 16, claim 16 and its dependent claims 17-23 and 25-27 are patentable.

Claim 28 recites elements substantially similar to those recited in claim 1. Even before amendments, the traversals of the combination and modification make the claim patentable. After amendment, the claim 28 recites that the deletion is a function of the software on the portable device. As explained above, the deletion function of Boyles is not performed by the software on the portable device, and thus, the modified combination does not show all the claim elements. Since the modified combination does not show all the claim elements, the Patent Office has not established obviousness for claim 28. Since the Patent Office has not established obviousness for claim 28, claim 28 and its dependent claims 29-32, 34, and 35 are patentable.

With respect to claims 4, 19, and 31, the Patent Office admits that the original modified combination of Paul and Boyles does not teach a claim element. The Patent Office attempts to cure this deficiency by opining that it would be obvious to further modify the combination to avoid manual configuration of the user interface (see Office Action, page 6). This asserted motivation is not supported with the mandated actual evidence. Since the motivation is not properly supported, the further modification is improper, and the Patent Office has not established obviousness for these claims.

With respect to claims 5, 20, and 32, the Patent Office admits that the originally modified combination of Paul and Boyles does not teach a claim element, but opines that it would be obvious to further modify the modified combination to avoid a manual configuration of the interface. Again, this asserted motivation to modify is not supported with the mandated actual evidence. Since the motivation is not properly supported, the further modification is improper, and the Patent Office has not established obviousness for these claims.

With respect to claims 15, 27, and 35, the Patent Office admits that the originally modified combination of Paul and Boyles does not teach a claim element, but opines that it would be obvious to further modify the modified combination to enable the user to change his or her settings in each session with the host computing device. Again, this asserted motivation to modify is not supported with the mandated actual evidence. Since the motivation is not properly supported, the further modification is improper, and the Patent Office has not established obviousness for these claims.

With respect to claims 12 and 25, the Patent Office admits that the originally modified combination of Paul and Boyles does not teach a claim element, but opines that it would be obvious to further modify the modified combination, and provides no motivation to modify them. Applicant traverses the rejection of these claims because there is no articulated motivation to modify the already modified combination, and further, because even if there is a motivation, the motivation is not supported with the mandated actual evidence. Since the motivation is not present and is not properly supported, the further modification is improper, and the Patent Office has not established obviousness for these claims.

With respect to claims 6-8 and 21-23, the Patent Office admits that the originally modified combination of Paul and Boyles does not teach a claim element, but opines that it would be obvious to further modify the modified combination to avoid a manual configuration of the interface. Again, this asserted motivation to modify is not supported with the mandated actual evidence. Since the motivation is not properly supported, the further modification is improper, and the Patent Office has not established obviousness for these claims.

With respect to claims 2, 17, and 29, the Patent Office provides an alternate motivation about the reason to combine the references; however, the new motivation is not properly supported. Furthermore, this alternate motivation does not cure the deficiencies of the earlier motivations. Likewise, this new motivation does not provide the missing element discussed above in the analysis of claim 1. To this extent, the Patent Office still has not established obviousness for the claims, and Applicant is entitled to a patent.

With respect to claim 14, the Patent Office admits that the originally modified combination of Paul and Boyles does not teach a claim element, but opines that it would be obvious to further modify the modified combination to avoid a manual configuration of the interface. Again, this asserted motivation to modify is not supported with the mandated actual

evidence. Since the motivation is not properly supported, the further modification is improper, and the Patent Office has not established obviousness for this claim.

Claims 13, 26, and 34 were rejected under 35 U.S.C. § 103 as being unpatentable over Paul in view of Boyles and further in view of Barth. Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses this rejection for the reasons that Applicant traversed the rejection of claims 1, 16, and 28. That is, the underlying modified combination of Paul and Boyles is improper. Applicant also traverses the combination of Paul, Boyles, and Barth. The Patent Office opines that the combination would be obvious "to prevent unauthorized access to data in the portable device." This motivation is not supported with the required actual evidence. Since the motivation is not properly supported, the further combination is improper. Since the Patent Office admits that the underlying combination of Paul and Boyles does not teach all the claim elements, the Patent Office has not established obviousness for these claims.

Applicant still further traverses the rejection because the underlying modified combination of Paul and Boyles does not teach all the claim elements for the independent claims. The addition of Barth does not cure the deficiencies of the underlying modified combination. To this extent, the Patent Office has not established obviousness, and the claims are allowable.

Claims 3, 18, and 30 were rejected under 35 U.S.C. § 103 as being unpatentable over Paul in view of Boyles and further in view of White et al. (hereinafter "White"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses this rejection for the reasons that Applicant traversed the rejection of claims 1, 16, and 28. That is, the underlying modified combination of Paul and Boyles is improper. Applicant also traverses the combination of Paul, Boyles, and White. The Patent Office opines that the combination would be obvious "to enable the user to transfer his or her browser settings from one host computing device to another." This motivation is not supported with the required actual evidence. Since the motivation is not properly supported, the further combination is improper. Since the Patent Office admits that the underlying combination of Paul and Boyles does not teach all the claim elements, the Patent Office has not established obviousness for these claims.

Applicant still further traverses the rejection because the underlying modified combination of Paul and Boyles does not teach all the claim elements for the independent claims.

The addition of White does not cure the deficiencies of the underlying modified combination. To this extent, the Patent Office has not established obviousness, and the claims are allowable.

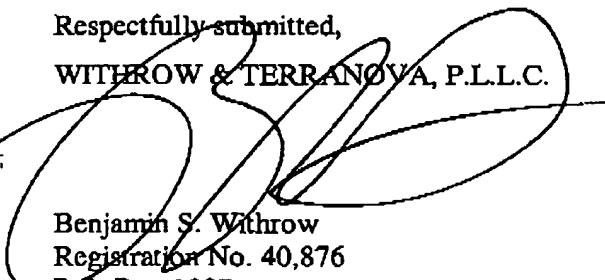
Claims 10 and 11 were rejected under 35 U.S.C. § 103 as being unpatentable over Paul in view of Boyles and further in view of Piosenka et al. (hereinafter "Piosenka"). Applicant respectfully traverses. The standard for obviousness is set forth above.

Applicant initially traverses this rejection for the reasons that Applicant traversed the rejection of claim 1. That is, the underlying modified combination of Paul and Boyles is improper. Applicant also traverses the combination of Paul, Boyles, and Piosenka. The Patent Office opines that the combination would be obvious "to prevent unauthorized access to data in the portable device." This motivation is not supported with the required actual evidence. Since the motivation is not properly supported, the further combination is improper. Since the Patent Office admits that the underlying combination of Paul and Boyles does not teach all the claim elements, the Patent Office has not established obviousness for these claims.

Applicant still further traverses the rejection because the underlying modified combination of Paul and Boyles does not teach all the claim elements for the independent claims. The addition of Piosenka does not cure the deficiencies of the underlying modified combination. To this extent, the Patent Office has not established obviousness, and the claims are allowable.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

<b>CERTIFICATE OF TRANSMISSION</b> I HEREBY CERTIFY THAT THIS DOCUMENT IS BEING TRANSMITTED VIA FACSIMILE ON THE DATE INDICATED BELOW TO:
Examiner: <u>Chandrasekhar, Pranav</u> Art Unit: <u>2115</u> Fax: <u>703-872-9306</u>
<u>Rebecca Rocks</u> Name of Sender
<u>Rebecca Rocks</u> Signature
<u>8/24/04</u> Date of Transmission

Respectfully submitted,  
WITHROW & TERRANOVA, P.L.L.C.  
By:   
Benjamin S. Withrow  
Registration No. 40,876  
P.O. Box 1287  
Cary, NC 27512  
Telephone: (919) 654-4520

Date: August 24, 2004  
Attorney Docket: 4989-004